

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today  
(1) was not written for publication in a law journal and  
(2) is not binding precedent of the Board.

Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte JAMES R. MARCUS

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Appeal No. 95-5039  
Application 07/979,018<sup>1</sup>

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HEARD: February 3, 1997

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Before COHEN, ABRAMS and NASE, Administrative Patent Judges.  
COHEN, Administrative Patent Judge.

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<sup>1</sup> Application for patent filed November 20, 1992.

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DECISION ON APPEAL

This is an appeal from the final rejection of claims 38 through 42. Claims 2, 4 through 6, 8, 14, 16 through 18, 25, 27, 28, 30, 33, 34, 36, 37, and 51 through 60, the only other claims remaining in the application, are considered by the examiner to be allowable over the prior art of record (Paper No. 10, page 2).

Appellant's invention pertains to an identification card. An understanding of the invention can be derived from a reading of exemplary claim 38 as it appears in the application file (pages 6 and 7 of Paper No. 6).

The following rejection is the sole rejection before us for review.

Claims 38 through 42 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

The full text of the examiner's rejection and response to the argument presented by appellant appears in the answer

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(Paper No. 17), while the complete statement of appellant's argument can be found in the substitute brief (Paper No. 16).

In the brief (page 3), appellant indicates that claims 38 through 42 stand or fall together. Thus, we focus upon selected independent claim 38.

#### OPINION

In reaching our conclusion on the indefiniteness issue raised in this appeal, this panel of the board has carefully considered appellant's specification and claim 38, and the respective viewpoints of appellant and the examiner. As a consequence of our review, we make the determination which follows.

We reverse the rejection of claim 38 under 35 U.S.C. § 112, second paragraph. It follows that claims 39 through 42 fall therewith.

The sole issue raised by the examiner regarding the content of claim 38 is its definiteness under 35 U.S.C. § 112, second paragraph.

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Under the statutory provision at issue, claims are required to particularly point out and distinctly claim the subject matter which is regarded as the invention. In other words, the metes and bounds of the claimed invention must be determinable.

In the present case, we share appellant's point of view to the effect that the claims would reasonably apprise those skilled in the art as to the metes and bounds of the subject matter being claimed.

Like appellant, we readily understand that the claimed identification card comprises, inter alia, an image of an object or other entity and a two dimensional barcode representation, which image and barcode representation are clearly defined aspects of the claimed card.

Additionally, we consider the claimed recitation of "an (sic, a) two dimensional barcode representation of an encrypted signal comprising a compressed representation of said image" to be definite in meaning, when read in light of the underlying dis-

closure. More specifically, the specification (page 3, lines 18 through 21) sets forth that a second signal is encrypted, which second signal is derived at least in part from a first signal

representative of the image. As subsequently stated in the specification (page 4, lines 16 through 24), the second signal (encrypted) includes a compressed form of the first signal. As indicated, the claim language at issue, understood in light of the specification, makes it clear to us that the encrypted signal includes a compressed form (reduction in bytes) of the first signal (representative of the image). To read the compressed representation of claim 38 as simply a form of encryption would be inconsistent with, rather than consistent with, appellant's disclosure which describes these terms separately and distinctly, one from the other (specification, pages 6 and 7; compressor module 16 and encrypter module 20 of Figure 1). See In re Bond, 910 F.2d 831, 833, 15 USPQ2d 1566, 1567 (Fed. Cir. 1990).

REMAND TO EXAMINER

U.S. Patent No. 5,471,533 to Wang et al (column 3, line 51 to column 4, line 35) has come to our attention. A copy of this patent is appended to our opinion.

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Under the circumstances of this particular case, we  
REMAND the application to the examiner for the following  
purposes:

to consider and cite upon a FORM PTO-892 the patent to  
Wang et al specified above,

to assess the subject matter of all pending claims  
(claims 2, 4 through 6, 8, 14, 16 through 18, 25, 27, 28, 30,  
33, 34, 36 through 42, and 52 through 61) in light of the newly  
discovered patent in conjunction with other known prior art,<sup>2</sup>  
and to take appropriate action; and

to take appropriate action on the "INFORMATION  
DISCLOSURE STATEMENT" (Paper No. 21) in accordance with 37 CFR  
§§ 1.97 and 1.98.

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<sup>2</sup> The office action dated August 12, 1993 (Paper No. 4)  
lists as attachments: 1. PTO-892 and 2. PTO-1449. While the  
referenced PTO-1449 is present in the application file, the  
PTO-892 citing the art made of record by the examiner cannot be  
found. We note the Leighton et al. patent (column 3, line 33  
through 61) cited by appellant on the PTO-1449, and the indi-  
cation by appellant in the present specification (pages 2  
through 4) that both encryption and signal compression are known.

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In summary, this panel of the board has:

REVERSED the examiner's rejection of claims 38 through  
42 under 35 U.S.C. § 112, second paragraph; and

REMANDED the application to the examiner for the  
purposes stated, supra.

The decision of the examiner is reversed.

This application has "special" status; MPEP  
§ 708.01(d).

REVERSED AND REMANDED

IRWIN CHARLES COHEN	)	
Administrative Patent Judge	)	
	)	
	)	
NEAL E. ABRAMS	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
	)	
	)	
JEFFREY V. NASE	)	
Administrative Patent Judge	)	

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